

REMARKS

Applicant's claims have been amended to better clarify Applicants' claimed invention. Applicants' claims have been amended to recite one or more first servers, where each of those one or more first servers comprises a storage management program. Support can be found in the written description at page 7 / line 23 through page 18 / line 8. Applicants' claims have been further amended to recite one or more second servers, where those one or more second servers do not comprise a storage management program. Support can be found in the written description at page 8 / lines 9 through 13.

Claims 15 and 27 have been amended to recite, *inter alia*, “determining using said one or more first servers if said information is stored on said selected hard disk,” where the underlined text comprises the amendment. Support can be found in the written description at page 22 / lines 14-15.

Claim 15 has been amended to cure an informality. More specifically, in claim 15 at line 13, “proving” has been amended to read --providing--.

No new matter has been entered. Reexamination and reconsideration of the application, as amended, is respectfully requested.

Claims 1, 2, 4, and 6-9, stand rejected under 35 U.S.C. § 102(b) as being anticipated by Korngiebel et al. (U.S. Pat. No. 5,416,914).

Claims 3 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Korngiebel et al in view of Osten (U.S.Pat. No. 5,948,075).

Claims 10-12 and 22-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Beglin (U.S. Pat. No. 5,469,560) in view of Applicants' admitted prior art.

LAW OFFICE OF
DALE F. REGELMAN, P.C.
4231 S. Fremont Street
Tucson, Arizona 85714

TEL 520-741-7636
FAX 520-746-9114

Claims 13, 14, 25, and 26, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rhoades (U.S. Pat. App. 2002/0087880) in view of Gniewek (U.S. Pat. No. 5,287,459) in further view of Applicants' admitted prior art.

Claims 15-21 and 27-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rhoades in view of Applicants' admitted prior art.

Claims 30-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rhoades in view of Gniewek.

Regarding the rejections of claims 1, 2, 4, and 6-9 as anticipated by Korngiebel et al., Korngiebel et al. teach a "removeable media management system that interfaces with the host computer operating system to direct all allocation activities . . ." Col. 2 / Lines 20 - 22.

Korngiebel et al. nowhere teach a data storage and retrieval system that includes one or more first servers, where each of those first servers comprises a storage management program, in combination with one or more second servers, where those second servers do not comprise a storage management program, as recited in Applicants' claim 1, as amended herein.

In addition, Korngiebel et al. nowhere teaches an information storage and retrieval system which includes one or more hard disks individually disposed in one or more portable hard disk drive units. The Office Action reads, in pertinent part, "[t]he examiner is considering a hard disk to be a form of solid-state memory." December 4, 2003 Office Action at page 3. Korngiebel et al clearly differentiate magnetic disks, i.e. hard disks, and solid state memory:

LAW OFFICE OF
DALE F. REGELMAN, P.C.
4231 S. Fremont Street
Tucson, Arizona 85714

TEL 520-741-7636
FAX 520-746-9114

Thus, there are a plurality of data storage media elements which differ in external physical dimensions (form factor), physical architecture (dual reel coaxial cartridge, dual reel coplanar cassette, single reel cartridge, etc.), media physical types (magnetic tape, magnetic disk, optical disk, solid state memory, etc.), and which vary in physical characteristics . . .

Korngiebel et al. at Col. 14 / Lines 25 - 32 (emphasis added). Korngiebel et al. clearly differentiate between magnetic disks, i.e. hard disks, and solid state memory.

The instant application also clearly differentiates magnetic storage media from electronic storage media. When describing portable data storage media, the instant Application reads that such media “are selected from the group consisting of a magnetic storage medium, an optical storage medium, an electronic storage medium, and the like.” Application at Page 27 / Lines 12-14, Page 28 / Lines 14-15, and Claims 31, 32, 33, 34, and 35. In addition, Applicants’ written description defines electronic storage medium “to mean a device such as a PROM, EPROM, EEPROM, Flash PROM, and the like.” Application at Page 27 / Lines 14-15. In accord with Korngiebel et al., Applicants’ written description clearly differentiates magnetic storage media, i.e. hard disks, and electronic storage media.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.Cir. 1987); MPEP 2131. Moreover, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed.Cir. 1989).

Korngiebel et al. nowhere teach a data storage and retrieval system that includes one or more hard disks individually disposed in one or more portable hard disk drive units, one or

LAW OFFICE OF
DALE F. REGELMAN, P.C.
4231 S. Fremont Street
Tucson, Arizona 85714

TEL 520-741-7636
FAX 520-746-9114

more first servers, where each of those first servers comprises a storage management program, and one or more second servers, where those second servers do not comprise a storage management program, as recited in Applicants' claim 1, as amended herein. This being the case, Applicants' respectfully submit that the rejection of claim 1 under 35 U.S.C. § 102(b) has been successfully traversed.

Claims 2, 4, and 6-9, depend, directly or indirectly, from claim 1. Under 35 U.S.C. § 112, fourth paragraph, "a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." Therefore, claims 2, 4, and 6-9, as amended herein, include all the elements of claim 1, as amended herein.

For the reasons set forth above, Applicants' respectfully submit that claim 1, as amended herein, is patentable over Korngiebel et al. This being the case, Applicants respectfully submit that the amendments of claims 2, 4, and 6-9, herein successfully traverse the rejections of those claims under 35 U.S.C. § 102(b) as unpatentable over Korngiebel et al.

Regarding the rejections of claims 3 and 5 as unpatentable over Korngiebel in view of Osten, Osten teaches an interface in a data-processing system for identifying operating parameters of storage systems and other elements within a storage system enclosure. Col. 1 / Lines 60 - 64. Osten nowhere teaches or suggests a data storage and retrieval system that includes one or more first servers, where each of those first servers comprises a storage management program, and one or more second servers, where those second servers do not comprise a storage management program, as recited in Applicants' claims 3 and 5, as amended herein.

"To establish prima facie obviousness of a claimed invention, all the claim limitations

LAW OFFICE OF
DALE F. REGELMAN, P.C.
4231 S. Fremont Street
Tucson, Arizona 85714

TEL 520-741-7636
FAX 520-746-9114

must be taught or suggested by the prior art.” MPEP 2143.03; *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Neither Korngiebel et al., nor Osten, singly or in combination, teach or suggest a data storage and retrieval system that includes one or more first servers, where each of those first servers comprises a storage management program, and one or more second servers, where those second servers do not comprise a storage management program. Therefore, Applicants respectfully submit that claims 3 and 5, as amended herein, are not rendered obvious by Korngiebel et al in view of Osten.

Regarding the rejections of claims 10-12 and 22-24 are unpatentable over Beglin in view of Applicants’ recitation of the prior art, Beglin nowhere teaches or suggests a data storage and retrieval system that includes one or more first servers, where each of those first servers comprises a storage management program, and one or more second servers, where those second servers do not comprise a storage management program, as recited in Applicants’ claims 10 and 22, as amended herein.

Neither Beglin, nor Applicants’ recitation of the prior art, singly or in combination, teach or suggest a data storage and retrieval system that includes one or more first servers, where each of those first servers comprises a storage management program, and one or more second servers, where those second servers do not comprise a storage management program. Therefore, Applicants respectfully submit that claims 10 and 22, as amended herein, are not rendered obvious by Beglin in view of Applicants’ recitation of the prior art.

Claims 11 and 12 depend from claim 10. Under 35 U.S.C. § 112, fourth paragraph, “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.” Therefore, claims 11 and 12, as amended herein, include all the

LAW OFFICE OF
DALE F. REGELMAN, P.C.
4231 S. Fremont Street
Tucson, Arizona 85714

TEL 520-741-7636
FAX 520-746-9114

elements of claim 10, as amended herein. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." MPEP 2143.03; *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988).

For the reasons discussed above, Applicants submit that claim 10 is non-obvious over Beglin in view of Applicants' recitation of the prior art. This being the case, Applicants further respectfully submit that claims 11 and 12, as amended herein, are also non-obvious over Beglin in view of Applicants' recitation of the prior art.

Claims 23 and 24 depend from claim 22. Under 35 U.S.C. § 112, fourth paragraph, "a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." Therefore, claims 23 and 24, as amended herein, include all the elements of claim 22, as amended herein. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." MPEP 2143.03; *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988).

For the reasons discussed above, Applicants submit that claim 22 is non-obvious over Beglin in view of Applicants' recitation of the prior art. This being the case, Applicants further respectfully submit that claims 23 and 24, as amended herein, are also non-obvious over Beglin in view of Applicants' recitation of the prior art.

Regarding the rejections of claims 13, 14, 25, and 26, as unpatentable over Rhoades in view of Gniewek, Rhoades teaches secure gateway multiple automated data storage system sharing. Paragraph [0015]. Rhoades nowhere teaches or suggests a data storage and retrieval system that includes one or more first servers, where each of those first servers comprises a storage management program, and one or more second servers, where those second servers do

LAW OFFICE OF
DALE F. REGELMAN, P.C.
4231 S. Fremont Street
Tucson, Arizona 85714

TEL 520-741-7636
FAX 520-746-9114

not comprise a storage management program, as recited by Applicants' claims 13 and 25, as amended herein.

Gniewek teaches a method for improving access time in an automated storage library by creating multiple copies of data on different recording media, with different arrangements of the data on each recording medium. Col. 3 / Lines 15-19. Gniewek nowhere teaches or suggests a data storage and retrieval system that includes one or more first servers, where each of those first servers comprises a storage management program, and one or more second servers, where those second servers do not comprise a storage management program, as recited by Applicants' claims 13 and 25, as amended herein.

Neither Rhoades, nor Gniewek, singly or in combination, teaches or suggests a data storage and retrieval system that includes one or more first servers, where each of those first servers comprises a storage management program, and one or more second servers, where those second servers do not comprise a storage management program. Therefore, Applicants respectfully submit that claims 13 and 25, as amended herein, are not rendered obvious by Rhoades in view of Gniewek.

Claim 14 depends from claim 13. Under 35 U.S.C. § 112, fourth paragraph, "a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." Therefore, claim 14, as amended herein, includes all the elements of claim 13, as amended herein. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." MPEP 2143.03; *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988).

For the reasons discussed above, Applicants submit that claim 13 is non-obvious over

LAW OFFICE OF
DALE F. REGELMAN, P.C.
4231 S. Fremont Street
Tucson, Arizona 85714

TEL 520-741-7636
FAX 520-746-9114

Rhoades in view of Gniewek. This being the case, Applicants further respectfully submit that claim 14, as amended herein, is also non-obvious over Rhoades in view of Gniewek.

Claim 26 depends from claim 25. Under 35 U.S.C. § 112, fourth paragraph, “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.” Therefore, claim 26, as amended herein, includes all the elements of claim 25, as amended herein. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” MPEP 2143.03; *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988).

For the reasons discussed above, Applicants submit that claim 25 is non-obvious over Rhoades in view of Gniewek. This being the case, Applicants further respectfully submit that claim 26, as amended herein, is also non-obvious over Rhoades in view of Gniewek.

Regarding the rejections of claims 15-21, and 27-29, as unpatentable over Rhoades in view of Applicants’ recitation of the prior art, Rhoades, singly or in combination with Applicants’ recitation of the prior art, nowhere teaches or suggests a data storage and retrieval system that includes one or more first servers, where each of those first servers comprises a storage management program, and one or more second servers, where those second servers do not comprise a storage management program, as recited in independent claims 15, 21, 27, and 29, as amended herein. Therefore, Applicants’ respectfully submit that claims 15, 21, 27, and 29, as amended herein, are non-obvious over Rhoades in view of Applicants’ recitation of the prior art.

Claims 16-20 depend, directly or indirectly, from claim 15. Under 35 U.S.C. § 112, fourth paragraph, “a claim in dependent form shall be construed to incorporate by reference all

LAW OFFICE OF
DALE F. REGELMAN, P.C.
4231 S. Fremont Street
Tucson, Arizona 85714

TEL 520-741-7636
FAX 520-746-9114

the limitations of he claim to which it refers.” Therefore, claims 16-20, as amended herein, include all the elements of claim 15, as amended herein. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” MPEP 2143.03; *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988). Therefore, Applicants respectfully submit that claims 16-20, as amended herein, are non-obvious over Rhoades in view of Applicants’ recitation of the prior art.

Claim 28 depends from claim 27. Under 35 U.S.C. § 112, fourth paragraph, “a claim in dependent form shall be construed to incorporate by reference all the limitations of he claim to which it refers.” Therefore, claim 28, as amended herein, include all the elements of claim 27, as amended herein. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” MPEP 2143.03; *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988). Therefore, Applicants respectfully submit that claims 28, as amended herein, is non-obvious over Rhoades in view of Applicants’ recitation of the prior art.

Regarding the rejections of claims 30-35 as obvious over Rhoades in view of Gniewek, neither Rhodes nor Gniewek, singly or in combination, teach or suggest a data storage and retrieval system comprising one or more first servers, where each of those first servers comprises a storage management program, and one or more second servers, where those second servers do not comprise a storage management program, as recited in independent claims 30 and 33, as amended herein. Therefore, Applicants respectfully submit that claims 30 and 33, as amended herein, are non-obvious over Rhoades in view of Gniewek.

Claims 31 and 32 depend from claim 30. Under 35 U.S.C. § 112, fourth paragraph, “a claim in dependent form shall be construed to incorporate by reference all the limitations of he

LAW OFFICE OF
DALE F. REGELMAN, P.C.
4231 S. Fremont Street
Tucson, Arizona 85714

TEL 520-741-7636
FAX 520-746-9114



claim to which it refers.” Therefore, claims 31 and 32, as amended herein, include all the elements of claim 27, as amended herein. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” MPEP 2143.03; *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988). Therefore, Applicants respectfully submit that claims 31 and 32, as amended herein, are non-obvious over Rhoades in view of Applicants’ recitation of the prior art.

Claims 34 and 35 depend from claim 33. Under 35 U.S.C. § 112, fourth paragraph, “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.” Therefore, claims 34 and 35, as amended herein, include all the elements of claim 33, as amended herein. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” MPEP 2143.03; *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988). Therefore, Applicants respectfully submit that claims 34 and 35, as amended herein, are non-obvious over Rhoades in view of Applicants’ recitation of the prior art.

Having dealt with all of the outstanding objections and/or rejections of the claims, Applicants submit that the application as amended is in condition for allowance, and an allowance at an early date is respectfully solicited. In the event there are any fee deficiencies or additional fees are payable, please charge them, or credit an overpayment, to our Deposit Account No. 502262.

Respectfully submitted,

Dale F. Regelman, Ph.D.
Attorney for Applicants
Reg. No. 45,625

A handwritten signature in black ink, appearing to read "Dale F. Regelman". Below the signature, the text "Respectfully submitted," is written in a smaller, printed font. Underneath the signature, the name "Dale F. Regelman, Ph.D." is printed, followed by "Attorney for Applicants" and "Reg. No. 45,625".

LAW OFFICE OF
DALE F. REGELMAN, P.C.
4231 S. Fremont Street
Tucson, Arizona 85714

TEL 520-741-7636
FAX 520-746-9114

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on March 9, 2004, at Tucson, AZ.

By: Dale F. Regelman

LAW OFFICE OF
DALE F. REGELMAN, P.C.
4231 S. Fremont Street
Tucson, Arizona 85714

TEL 520-741-7636
FAX 520-746-9114